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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,730	01/26/2004	Norbert Miller	SWR0124US	1107
23413 7590 02/01/2010 CANTOR COLBURN, LLP 20 Church Street 22nd Floor Hartford, CT 06103				
EXAMINER JOHNS, CHRISTOPHER C				
ART UNIT 3621		PAPER NUMBER		
NOTIFICATION DATE 02/01/2010		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

usptopatentmail@cantorcolburn.com

Office Action Summary

Application No.

10/765,730

Applicant(s)

MILLER ET AL.

Examiner

Christopher C. Johns

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 January 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1, 2, 5, 6 and 9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5, 6 and 9 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/GS/US)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Acknowledgements

1. This Office Action is given Paper No. 20100127 for reference purposes only.
2. This Office Action is in response to the Request for Continued Examination, filed by Applicants on 15 January 2010.
3. All references to the capitalized version of "Applicant" refer specifically to the Applicants of record in the instant application. Any references to lowercase versions of "applicant" or "applicants" refer to any or all patent applicants. Unless expressly noted otherwise, references to the capitalized version of "Examiner" refers to the Examiner of record while reference to or use of the lower case version of "examiner" or "examiners" refers to examiner(s) generally. The notations in this paragraph apply to any future Office actions from this Examiner.
4. Claims 1, 2, 5, 6, and 9 are pending.
5. Claims 1, 2, 5, 6, and 9 have been examined.

Continued Examination Under 37 CFR 1.114

6. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 January 2010 has been entered.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1, 2, 5, 6, and 9 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

9. Independent claim 1 recites “providing visual verification to an operator...accepting the document when the document passes the visual verification”. The phrase “when the document passes the visual verification” would be unclear to a person having ordinary skill in the art because it would be unclear what the action being performed is. “Visual verification” is understood to be the provision of an image to the operator in order for the operator to pass judgment on the suspect document. The specification refers to this “visual verification” as “the document can be presented to an operator” (page 3, ¶3, lines 2-3). It would be unclear, therefore, how the presentation of an image can “[pass]” or “not pass” the visual verification (claim 1, lines 19-20). Additionally, it is unclear who or what is performing the action of “visual verification”; while the claim recites that the image is presented to the operator in the guise of “visual verification”, the claims do not recite that the user is the one who “accepts” the document, nor do they recite that the user is the one who allows the document to “[pass]”.

10. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2nd paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art

rejections even though claims may be indefinite, the claims are construed and the prior art is applied as much as practically possible.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claims 1, 2, 5, 6 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over United States Patent Application Publication 2003/0131239 ("Greene") in view of U.S. Patent Application Publication 2003/0059098 ("Jones").

13. As per claim 1, Greene discloses:

14. feeding the document to a verification unit by means of an input unit, wherein the verification unit is provided for authenticating the document (figure 6, reference 300);

15. authenticating the document (figure 2);

16. determining a probability of authenticity of the document (Abstract, "verification one-way hash is then compared to the appended one way hash and the authenticity of the document is verified based on the results of the comparison");

17. accepting the document as positively authenticated with the probability meets predetermined criteria (Abstract, "verification one-way hash is then compared to the appended one way hash and the authenticity of the document is verified based on the results of the comparison").

18. Greene does not explicitly disclose:
19. providing a sales machine which allows a customer to purchase goods and/or services against payment by providing a document as cash in the form of banknotes or vouchers;
20. wherein said authenticating the document is performed with a combination of at least two different verification methods;
21. comparing the at least two verification methods with verification specifications;
22. providing visual verification to an operator when the probability does not meet the predetermined criteria and the document is negatively authenticated;
23. recording the document as an image and presenting the image to the operator;
24. accepting the document when the document passes the visual verification;
25. refusing acceptance when the document does not pass the visual verification.
26. Jones teaches:
27. providing a sales machine (figure 2, reference 100) which allows (in light of the below definition of “allow”, as the machine does not “prevent” or “forbear” a customer from using currency, the machine “allows” a customer to do so) a customer to purchase goods and/or services against payment by providing a document as cash in the form of banknotes or vouchers (§1 - “currency bills”);
28. wherein said authenticating the document is performed with a combination of at least two different verification methods (§60 - “other counterfeit tests are run on the bill”);
29. comparing the at least two verification methods with verification specifications (in order to pass a test, the test must inherently be run against pre-determined specifications);

30. providing visual verification to an operator when the probability does not meet the predetermined criteria and the document is negatively authenticated (§60 - “If the currency bill fails (answer is no to question of whether the currency bill passed all the other tests), the scanning device proceeds to step 250 and continues as stated above”);
31. recording the document as an image and presenting the image to the operator (§66 - “signature from the check could be displayed on a screen for an operator”);
32. accepting the document when the document passes the visual verification (§66 - “If the signatures are the same, the operator may choose to accept the check and indicate such on the device”);
33. refusing acceptance when the document does not pass the visual verification (§66 - “Alternatively, the operator may choose not to accept the item and also indicate such”).
34. Jones teaches visual and other verification methods in order to create a more secure system. A person having ordinary skill in the art would understand that, by using two verification methods, and permitting an operator to visually inspect and override a decision by the machine, the probability of passing a fake bill as a real bill would be reduced compared to using only one verification method. This creates a more secure system (because of the number of verification methods), a more fail-safe system (because of the ability to override a machine’s decision), and a more profitable system (because users are more likely to purchase and use a system that is secure and fail-safe); all things that a person having ordinary skill in the art would see as advantageous.
35. Therefore, it would have been obvious to a person having ordinary skill in the art to include in Greene the multiple verification methods as taught by Jones, since the claimed

invention is merely a combination of old elements, and in the combination, each element merely would have performed the same function as it did separately. A person having ordinary skill in the art would have recognized that the results of the combination were predictable, as well as advantageous because it would create a more secure, fail-safe, and profitable system that would not be as able to be tricked into accepting fake documents.

36. As per claims 2, 5, 6, and 9, Greene in view of Jones discloses as above, and further discloses:

37. two verification methods are selected from the group comprising magnetic verification (§60 - “magnetic tests”), infrared verification (§60 - “infrared tests”), UV verification (§60 - “UV tests”), and visual verification (§93 - “fluorescent”);

38. visual verification method is performed only on documents of a desired value (if the operator desires to scan the documents, then they are scanned);

39. visual verification method is performed via a direct visual authentication of the document (§66 - “displayed on a screen for an operator”);

40. operator is an entity other than the customer (Jones, §149 - “if it was a forgery, an operator may know to take a close look at the signature”; if the customer were the one operating the machine in Jones, he would not need to attempt to verify his own signature).

Claim Interpretation

41. The Examiner hereby adopts the following definitions under the broadest reasonable interpretation standard. In accordance with *In re Morris*, 127 F.3d 1048, 1056, 44 USPQ2d 1023,

1029 (Fed. Cir. 1997), the Examiner points to these other sources to support his interpretation of the claims. Additionally, these definitions are only a guide to claim terminology since claim terms must be interpreted in context of the surrounding claim language. Finally, the following list is not intended to be exhaustive in any way:

42. *Allow*: “3 b : to forbear or neglect to restrain or prevent.” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

43. *For*: “1 a -- used as a function word to indicate purpose... b -- used as a function word to indicate an intended goal.” Webster's Ninth New Collegiate Dictionary, Merriam-Webster Inc., Springfield MA, 1986.

Response to Arguments

44. Applicants' arguments with respect to the claims have been considered but are moot in view of the new ground of rejection. They argue limitations that were not previously in the claims – as they have been fully addressed in this Office Action, the arguments are overcome.

Conclusion

45. Applicant's amendment, filed on 15 January 2010, necessitated the new ground of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

46. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO

MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

47. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher C. Johns whose telephone number is (571)270-3462. The examiner can normally be reached on Monday - Friday, 9 am to 5 pm.

48. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Fischer can be reached on (571) 272-6779. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

49. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher C Johns/
Examiner, Art Unit 3621

/Calvin L Hewitt II/
Supervisory Patent Examiner, Art Unit 3685